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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/328,417 | 06/09/1999 | MANUEL A. CORREA JR | | 6806 |

7590 12/17/2002
Mr. Manuel Correa
3617 Toddsbury Lane
Olney, MD 20832

EXAMINER

COSIMANO, EDWARD R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3629

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,417

Applicant(s)

CORREA JR, MANUEL A.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82-111 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.1 Claims 82, 85, 90-95, 97 & 104-109 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Fabel (4,461,661).

3.1 In regard to claims 82, 85, 90-95, 97 & 104-109, Fabel ('661), which discloses a mailing comprised of a number of attached layers/plies with selective carbon spotting to the multiple layers/plies in order to selectively transfer information applied to the top layer to underlying layers and wherein (1) two of the layers are combined to form the mailing envelope, and (2) any suitable weight/bond of paper may be used for each layer. Further a tear strip is used to aid the recipient in opening the mailing.

3.1.2 It is respectfully noted that the system of Fabel ('661) would transfer the information printed on the top/originating slip to the appropriately aligned portion of the lower layers that are positioned directly vertically below the portion of the top layer that received the corresponding printed information.

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3.1.3 It is further respectfully noted that it is inherent in Fabel ('661) that the arrangement and location of perforations, tear strips and reinforcements of the claimed assembly are governed by the machines used to process the assembly of Fabel ('661) so that these machines used will not damage the assembly of Fabel ('661).

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4.1 Claims 83, 84, 86-88, 96 & 98-101 are is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel (4,461,661) as applied to above claims 82, 85, 90-95, 97 & 104-109 and further in view of an obvious modification based on applicant's admitted prior art.

4.1.1 In regard to claims 83, 84, 87 & 98-100, since applicant admits that:

A) the Post Office requires a 90% readability of applied barcodes (see the last full paragraph of page 3);

B) the Post Office provides discounts for the application of information such as postal barcodes and facer identification marks (FIM) to items of mail (see the first full paragraph of page 2 and the paragraph bridging pages 2-3), see below in regard to the placement of this information on items of mail;

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C) the Post Office uses optical character recognition (OCR) and barcode readers (BCR) to scan information applied to a mailing (see the paragraph bridging pages 1-2); and

D) the machines used by the Post Office to sort mail sometimes smears the applied barcodes so that the barcode is illegible, (see second full paragraph on page 1, “The present invention ... smeared by the post office processing equipment.”); it would have been obvious to one of ordinary skill at the time the invention was made that if the user of the mailer of Fabel ('661) were to apply barcodes to the out going and return envelopes to obtain a postal discount, then the applied barcodes and FIMs would be placed on the envelopes at a location which:

(1) may be read by the equipment used by the Post Office;

(2) is protected from being made illegible by the equipment used by the Post Office; and

(3) has suitable contrast with the background color of the mailing so as to aid in the recognition of the barcode.

4.1.2 In regard to claims 99 & 100, it is noted that since Fabel ('661) discloses that the use of FIMs reduces the associated postage costs, it would have been obvious to one of ordinary skill at the time the invention was made that the FIM applied to the out going envelope could be also applied to the return envelope using the transfer process of Fabel ('661).

4.1.3 In regard to claims 86, 88 & 89, since Fabel ('661) explicitly suggests:

A) the need to use paper with sufficient weight/bond in order to obtain the desired result of the system of Fabel ('661); and

B) the layers/plies of the mailing are bonded together;

it would have been obvious to one of ordinary skill at the time the invention was made that if the user of the mailer of Fabel ('661) would use any suitable bonding means and weight/bond of paper to form each layer/ply of the item of mailing so as to form a complete mailing that is suitable for reaching the recipient and accomplishing the purpose of returning reply of recipient to the original sender.

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4.1.4 In regard to claim 96, since Fabel ('661) explicitly suggests using a tear strip to aid the recipient in opening the mailing, it would have been obvious to one of ordinary skill at the time the invention was made that the tear strip of the system of Fabel ('661) could be placed in any suitable location on the mailing so that the mailing may reach the recipient intact.

4.2 Claims 102-103 are is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fabel (4,461,661) as applied above to claims 82, 85, 90-95, 97 & 104-109 and further in view of an obvious modification.

4.2.1 In regard to the use of a security screed in claims 102-103, since it is conceivable that the user of the mailer of Fabel ('661) would use the mailer to send confidential mail, it would have been obvious to one of ordinary skill at the time the invention was made that the mailer of Fabel ('661) could be modified to use security screens so as to prevent unauthorized reading of confidential information applied to the mailer of Fabel ('661).

4.3 In regard to the use of color in claim 87, it is noted that the color does not affect the operation of the system or the function of the claimed item, hence the use of color is nonfunctional descriptive material that cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

5.1 A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 102 and 35 U.S.C. § 103 rejection, since:

A) these rejection have been modified to address applicant's concerns, applicant's argument's are non persuasive.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

7.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

7.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

7.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

12/15/02



Edward R. Cosimano
Primary Examiner A.U. 3629